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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,359	01/28/2004	Hiroaki Kishioka	Q79-404	1537
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,359

Applicant(s)

KISHIOKA ET AL.

Examiner

ANISH DESAI

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments in response to the Office action dated 12/26/07 have been fully considered.
2. Claims 1, 2, 5, and 6 are pending. Claims 3 and 4 are cancelled. Support for newly amended claim 1 is found in the specification.
3. All of the previously made art rejections are maintained.
4. English translation of Okabe et al. (JP 07-105781) is provided with this Office Action.
5. It is noted that in 12/26/07 Office Action, the Examiner had inadvertently referred to "claim 3" instead of "claim 1" on page 5, first full paragraph of 12/26/07 Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kishioka (US 2002/0098352 A1) in view of Hitoshi et al. (EP 0930322A2), substantially as set forth in the Section 7 of 12/26/07 Office Action.
7. With respect to claims 1 and 5, the claim preamble is directed to a double-sided pressure sensitive adhesive sheet. Therefore, recitations "sheet to be used in sticking and fixing a touch panel to a display surface of a display device", "adhesive sheet is

capable of being adhered substantially entirely on the touch panel, and the other surface is capable of being adhered substantially entirely on the display surface of the display device", "it is repeatedly peelable against at least one surface of the touch panel and the display surface of the display device", and "which is used for fixing a display device to touch panel in the inner touch panel system" (claim 5) are interpreted as an intended use of the pressure sensitive adhesive sheet and they are not part of the structure of the PSA sheet that is claimed. While some of the above listed features are functional in nature, there is no evidence of record to indicate that the adhesive material of the below combined prior art would not have the capability of functioning as claimed.

8. Kishioka discloses a pressure-sensitive adhesive composition and a pressure-sensitive adhesive sheet that is used to stick and fix an optical film on the display panel of a display device (abstract). As to the claim limitations of double-sided pressure sensitive adhesive tape having at least two pressure-sensitive adhesive layers but does not have a substrate, it is noted that Kishioka discloses "The pressure-sensitive adhesive layer can be constituted of a plurality of layers through another layer or through no another layer" (0065). Moreover, the thickness of the pressure sensitive adhesive layer of Kishioka is generally in the range of from 5 to 500 μm , preferably from 10 to 100 μm (0064). As to the claim requirement of "Wherein the respective pressure-sensitive adhesive layers each comprise an acrylic polymer containing a (meth)acrylic acid alkyl ester in which alkyl...dodecyl (meth)-acrylate", the pressure sensitive adhesive of Kishioka is formed of acrylic polymer comprising monomer components of the aromatic ring-containing copolymerizable monomers, the copolymerizable

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monomers containing no aromatic ring, the monomer for modification etc. (0043). As monomers containing no aromatic ring, Kishioka discloses monomers such as alkyl (meth)acrylates wherein the alkyl group has from one to 18 carbons. These monomers are methyl (meth)acrylate, ethyl(meth)acrylate etc. (see 0038-0039).

9. The difference between the claimed invention and the prior art of Kishioka is that Kishioka is silent with respect to teaching "the proportion of the major monomer component constituting each pressure-sensitive adhesive layer is 80% by weight or more based on the whole amount of monomer components.". However, the weight percent of such monomers are taught by Hitoshi, specifically in the abstract and at 0008. Hitoshi discloses a pressure-sensitive adhesive sheet based on acrylic adhesives that is useful as fixing tape, masking tapes, etc. for electronic parts (0002-0003). The adhesive tape of Hitoshi comprises from 70 to 100% by weight of a (meth)acrylic acid alkyl ester having on average 2 to 14 carbon atoms of the alkyl group based on the total amount of the monomers (0008). Additionally, the disclosure of Hitoshi at paragraph 0017 is interpreted as the presence of 70% to 100% by weight of (meth) acrylic acid alkyl ester monomer provides well balanced adhesive property and heat resistance. Further, the adhesive sheet of Hitoshi is excellent in transparency, foaming resistance, low out-gassing property, heat resistant and weather resistant (abstract). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the proportion of the major monomer component in the amount of 80% by weight or more in the pressure-sensitive adhesive layer,

motivated by the desire to form the pressure-sensitive adhesive tape having excellent in foaming resistance, low gas-out property, the discoloring resistance, and transparency.

10. As to the claim limitations of the PSA having optical isotropy and newly amended claim limitation of "wherein the pressure-sensitive adhesive layer in the touch panel side has a...so that the double-sided pressure-sensitive adhesive sheet is repeatedly peelable from the display surface of the display device together with the touch panel", these limitations are believed to be present in the double-sided pressure sensitive adhesive tape of Kishioka (US 2002/0098352 A1) and Hitoshi et al. (EP 0930322A2) taken together. The support for the Examiner's position is based on the fact that the double-sided adhesive tapes of Kishioka as modified by Hitoshi and that of Applicant are structurally and compositionally equivalent. Specifically, the double-sided pressure sensitive adhesive tapes of Kishioka as modified by Hitoshi and Applicant comprise at least two pressure-sensitive adhesive layers wherein the PSA layers comprise an acrylic polymer as set forth in claim 1. Therefore, the aforementioned claim limitations would be present. The burden is shifted to Applicant to prove it otherwise (*In re Fitzgerald*, 205 USPQ 594).

11. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okabe et al. (abstract of JP 07-105781) in view of Kishioka (US 2002/0098352A1) and Hitoshi (EP 0930322A2), substantially as set forth in the Section 8 of 12/26/07 Office Action.

12. Okabe discloses a transparent touch panel structure wherein the transparent touch panel and the display panel is stuck to each other by an acrylic adhesive with good transparent property (see abstract). Okabe is silent with respect to teaching the double-sided adhesive tape as presently claimed in claims 1 and 2. However, the inventions of Kishioka and Hitoshi are previously disclosed in Section 10 above and they are incorporated here by reference. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the double-sided adhesive tape of Kishioka and Hitoshi in the invention of Okabe, motivated by the desire to provide suitable tape that can bond the display device and the touch panel.

Response to Arguments

13. Applicant's arguments received on 05/27/08 have been considered but they are not found persuasive.

14. With respect to the art rejections of Kishioka (US 2002/0098352) in view of Hitoshi (EP0930322), Applicant argues that none of the cited references teach or suggest the claim limitation of "the pressure-sensitive adhesive layer in the touch panel side...repeatedly peelable from the display surface of the displace device together with the touch panel." (page 5 of 05/27/08 amendment). The Examiner respectfully disagrees for the reasoning set forth on page 5 of 12/26/07 Office Action and in the Section 10 of this Office Action. Further, there is no factual evidence on the record that would indicate that the aforementioned claim limitation would not have been present in

the double sided adhesive tape of Kishioka as modified by Hitoshi. Accordingly, it is respectfully submitted that Applicant's arguments are not found persuasive.

15. Applicant argues that there is no teaching or suggestion in Hitoshi that at least two-pressure sensitive adhesive layers are constituted from the same kind of monomer and the proportion of the major component is 80% by weight or more. Especially, Hitoshi only discloses a pressure-sensitive adhesive layer of a single layer form. The Examiner respectfully disagrees for the following reasons:

16. The Examiner is not relying on Hitoshi to disclose that both PSA layers are formed of the same kind of monomers. The primary reference of Kishioka is relied upon to teach that both PSA layers are formed of same kind of monomers. Specifically, Kishioka's disclosure at paragraph 0065 discloses that the same adhesives are used in forming plurality of PSA layers. The secondary reference of Hitoshi is relied upon to render claim limitation of "the major monomer component constituting...based on the whole amount of the monomer components." obvious. Specifically, Hitoshi discloses a PSA sheet comprising 100 parts by weight of monomers composed of from 70 to 100% by weight of a (meth) acrylic acid alkyl ester (abstract). As to the argument that Hitoshi only discloses a PSA of a single layer form, this argument is not found persuasive because the disclosure of Hitoshi at paragraph 0036 is interpreted to read on the double-sided adhesive tape. Accordingly, it is respectfully submitted that Applicant's arguments are not found persuasive.

17. With respect to the art rejections based on Okabe et al. JP07-105781 (Applicant refers to it a "Minoru et al.") in view of Kishioka and Hitoshi, Applicant has essentially

taken the same position as that of for the art rejections based on Kishioka in view of Hitoshi. Specifically, Applicant argues that "none of the cited references teaches or suggest the feature of the present invention in which the adhesive strengths of both surface layers of the double-sided pressure-sensitive adhesive sheet are specifically to enable repeat peeling of the double-sided pressure-sensitive adhesive sheet from the display surface of the display device together with the touch panel." (pages 6-7 of 05/27/08 amendment). The Examiner respectfully disagrees for the reasons set forth in the Sections 11 and 14 of this Office Action. It is noted that Applicant has generally argues that the aforementioned limitations are not present in the invention of Okabe in view of Kishioka and Hitoshi without providing any factual evidence or explanation as to why these limitations would not be present. Accordingly, Applicant's arguments are not found persuasive.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
19. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

/Hai Vo/

Primary Examiner, Art Unit 1794